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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,603	04/28/2000	Mark R. Sendo	SSO-10002/29	4629

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/560,603

Applicant(s)

SENDO ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.                            2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-9 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) 10-17 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 drawn to conducting secure transactions over a network, classified in class 705 subclass 53.
  - II. Claims 10-17, drawn to computer input/output systems, classified in class 710.

The examiner notes that in the original document claim 11 was omitted and subsequent claims were renumbered as appropriate.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a diskette drive is not necessary to transfer data securely between computers. The subcombination has separate utility such as storing computer data.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Via Paper No 6 filed September 11, 2002 a provisional election was made with traverse to prosecute the of invention I, claims 1- 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant's election with traverse of invention I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the independent inventions are intended for use together. This is not found persuasive because Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as providing content material. See MPEP § 806.05(d).

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-9 have been examined

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1–9 are rejected under 35 U.S.C. 103(a) as being anticipated by Rowney et al. (US Patent 5,996,076)

As per claim 1,

Rowney et al. ('076) discloses a method of securely transferring data having a corresponding equivalent monetary value in a communications system including a first device having a first set of data encoded thereon, a second device having a second set of data thereon, and a third device having a third set of data encoded thereon, the method comprising the steps of: sending a request to perform a transaction from the first device to the second device; (Column 14, lines 55-61)

retrieving the first set of data from the first device; (Column 14, lines 55-61)

transmitting the first set of data from the first device to the third device; (Figure 3— the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

transmitting the data from the second device to the third device; (column 15, lines 47-50)

transmitting an instruction from the third device to the second device whereby the second device completes the transaction request according to a predetermined process. (Column 15, lines 45-53)

Official Notice is taken that “comparing the first set of data to the third set of data for verification purposes” is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the first set of data to the third set of data for verification purposes because this prevents fraud. The examiner notes that any modern POS type transaction system verifies the consumers account data.

As per claim 2,

Rowney et al. ('076) discloses a method as recited in claim 1, wherein the first device is a medium capable of storing data for retrieval by a disk drive. (Figure 1A)

As per claim 3,

Rowney et al. ('076) discloses a method as recited in claim 2, whereby the communications link is the Internet network. (Column 4, lines 52-54)

As per claim 4,

Rowney et al. ('076) discloses a system for conducting secure transactions over a network, comprising:

a secure device controlled by a consumer, wherein said secure device comprises data read and transmitted over the network by a computer device;(Figure 1A)

a second device having a transaction data set, wherein the second device receives the data from the secure device and forwards the data and a portion of the transaction data over the network;(Figure 2)

an authentication device, wherein said authentication device verifies the data originating from the secure device and the portion of the transaction data set originating from the second device, and forwards via the network an authorization message to the second device for completion of the secure payment transaction.(Figure 3 -- the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

As per claim 5,

Rowney et al. ('076) discloses the system of claim 4,

wherein the data is encrypted. (Figure 4)

As per claim 6,

Rowney et al. ('076) discloses the system of claim 4,  
wherein the transaction data set is encrypted.(Figure 10)

As per claim 7,

Rowney et al. ('076) discloses the system of claim 4,  
wherein the authorization message is encrypted.(Figure 4)

As per claim 8,

Rowney et al. ('076) discloses the system of claim 4,

Official Notice is taken that "the secure device comprises a self contained, portable unit" is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the secure device comprises a self contained, portable unit because portable secure self contained devices are inexpensive and easily obtained by consumers. The examiner notes that the limitations of this claim are met by many PDA's and handheld devices currently available on the market.

As per claim 9,

Rowney et al. ('076) discloses the system of claim 4,

Official Notice is taken that "comprising dimensions approximately the size of a credit card" is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the device would comprise the dimensions approximately the size of a credit card because this allows the consumer the convenience of carrying the device in a wallet or a purse . The examiner notes that the limitations of this claim are met by many smart cards.

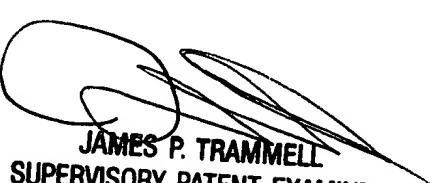
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
October 8, 2002



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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